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8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
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11 CARY A. JARDIN, ) No. 11-CV-87-IEG(WVG)  
12 )  
12 Plaintiff, ) **ORDER GRANTING IN PART AND**  
13 ) **DENYING IN PART PLAINTIFF'S**  
13 v. ) **MOTION TO COMPEL**  
14 )  
14 DATALLEGRO, INC., *et al.*, ) [DOC. NO. 1]  
15 )  
15 Defendants. )  
16 )  
16 \_\_\_\_\_ )

17 This case appeared on the Court's docket when the United  
18 States District Court for the Western District of Washington  
19 transferred Plaintiff's motion to compel Microsoft, Inc., to respond  
20 to Plaintiff's requests for document production in Jardin v.  
21 DATALlegro, Inc., et al., S.D. Cal. No. 08-CV-1462-IEG(WVG) ("2008  
22 Case"). The only issue for resolution in the instant case remains  
23 Plaintiff's motion to compel, which the Court finds suitable for  
24 decision without oral argument. S.D. Cal. Civ. L. R. 7.1. For the  
25 reasons stated below, Plaintiff's motion is GRANTED IN PART and  
26 DENIED IN PART.

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I. BACKGROUND

Before Plaintiff's claims were summarily adjudicated in Defendants' favor, he alleged patent infringement against Defendants Frost and DATAlegro, Inc., which has been purchased by non-party Microsoft, Inc. On September 30, 2010, Plaintiff served Microsoft with a subpoena *duces tecum* that sought various categories of documents related to Microsoft's purchase of DATAlegro. Although it appears that Microsoft initially complied by producing some documents, the company later refused to produce other documents it found. The instant motion to compel followed on December 20, 2010, in Washington.

On January 14, 2011, the fully-briefed motion was transferred to this Court after Plaintiff and Microsoft jointly moved for the transfer. (Doc. Nos. 11-13.)<sup>1/</sup> At that time, Microsoft "expressly consent[ed] to the transfer for the limited purpose of resolving the pending discovery dispute," (Doc. No. 11 at 2:3-4), and "agree[d] to be bound by, and comply with, any order issued from [this Court]," (*id.* at 2:19-3:1).

On February 4, 2011, this matter was low-numbered to the 2008 Case. On February 18, 2011, Defendants asked for a stay of discovery in the 2008 Case pending the outcome of a motion to dismiss that was pending in another related case, Jardin v. DATAlegro, Inc. et al., S.D. Cal. No. 10-CV-2552-IEG(WVG) ("2010 Case"). (Doc. No. 155.)

On March 23, 2011, the Court stayed discovery after hearing arguments and deferred ruling on the present motion until the stay

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<sup>1/</sup> Page references to documents on the Court's docket are to the CM/ECF pagination, not the document's native pagination.

1 lifted. (Doc. No. 188.) On April 12, 2011, the stayed lifted after  
 2 Judge Gonzalez ruled on Defendants' motion to dismiss in the 2010  
 3 Case. (Doc. No. 205.)

## 4 **II. LEGAL STANDARD**

5 A motion to compel is appropriate when a party fails to  
 6 produce relevant, non-privileged documents that a party has  
 7 subpoenaed. Fed. R. Civ. P. 45(c)(2)(B)(i). The party seeking to  
 8 compel compliance bears the burden of establishing that its document  
 9 requests satisfy the relevancy requirements of Rule 26(b)(1).<sup>2/</sup> See  
 10 Soto v. City of Concord, 162 F.R.D. 603, 610 (N.D. Cal. 1995)  
 11 (finding that a relevant matter is "any matter that bears on, or  
 12 that reasonably could lead to other matters that could bear on, any  
 13 issue that is or may be in the case."). Moreover, the scope of  
 14 federal discovery is broad. See Herbert v. Lando, 441 U.S. 153, 177  
 15 (1979); Epstein v. MCA, Inc., 54 F.3d 1422, 1423 (9th Cir. 1995)  
 16 ("[W]ide access to relevant facts serves the integrity and fairness  
 17 of the judicial process by promoting the search for truth."). The  
 18 broad scope of permissible discovery encompasses "any matter that  
 19 bears on, or that reasonably could lead to other matter that could  
 20 bear on, any issue that is or may be in the case." Doe v. Archdio-  
 21 cese of Portland, 717 F. Supp. 2d 1120, 1126 (D. Or. 2010) (citing  
 22 Oppenheimer Fund, Inc. v. Sanders, 437 U.S. 340, 351 (1978)).

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23  
 24 <sup>2/</sup> Rule 26's use of "relevant to the subject matter" is interpreted  
 25 broadly, and includes information that might "reasonably assist a  
 26 party in evaluating the case, preparing for trial, or facilitating  
 27 settlement." Moe v. Sys. Transp., Inc., 270 F.R.D. 613, 618 (D.  
 28 Mont. 2010). Even if it would not be admissible at trial, relevant  
 information may be discoverable if it "appears reasonably calculated  
 to lead to the discovery of admissible evidence." Fed. R. Civ. P.  
 26(b)(1). Hearsay or nonhearsay information relating to the  
 credibility of witnesses or other evidence in the case may be  
 relevant to the subject matter of the action. Oakes v. Halvorsen  
Marine Ltd., 179 F.R.D. 281, 284 (C.D. Cal. 1998); Ragge v.  
MCA/Universal Studios, 165 F.R.D. 601, 603-04 (C.D. Cal. 1995).

1 Discovery is not limited to the merits of a case, "for a variety of  
 2 fact-oriented issues may arise during litigation that are not  
 3 related to the merits." Id. Courts have "wide latitude in  
 4 controlling discovery, and [their] rulings will not be overturned in  
 5 the absence of a clear abuse of discretion." Volk v. D.A. Davidson  
 6 & Co., 816 F.2d 1406, 1416-17 (9th Cir. 1987).

7 After the moving party makes the requisite showing of  
 8 relevance, the party opposing the discovery has the burden of  
 9 showing that it should be prohibited, as well as the burden of  
 10 clarifying, explaining, and supporting its objections. DIRECTV,  
 11 Inc. v. Trone, 209 F.R.D. 455, 458 (C.D. Cal. 2002) (citing  
 12 Blankenship v. Hearst Corp., 519 F.2d 418, 429 (9th Cir. 1975)).

### 13 **III. DISCUSSION**

#### 14 **A. Relevancy Predicated on Plaintiff's Former Claims**

15 Plaintiff's subpoena contains fourteen document categories.  
 16 Microsoft objected on the ground, *inter alia*, that the documents are  
 17 not relevant. Plaintiff's current proffer of relevancy relies  
 18 heavily on the following argument: "[T]he documents identified by  
 19 Microsoft relate to its evaluation of the accused technology and, at  
 20 a minimum, are relevant to Jardin's proof of infringement and value  
 21 of the accused technology. The other requested documents are  
 22 likewise relevant to Jardin's damages theories, infringement  
 23 theories and defenses." (Doc. No. 1 at 4:17-20.) However, this  
 24 argument is no longer valid in light of recent events in the 2008  
 25 Case.

26 On April 1, 2011, Judge Gonzalez granted *in toto* Defendants'  
 27 motion for summary judgment of non-infringement. (Doc. No. 191.)  
 28 On April 11, 2011, Judge Gonzalez denied Plaintiff's motion for

1 summary judgment of infringement. (Doc. No. 197.) These orders  
2 resulted in the complete disposition of Plaintiff's case. As a  
3 result, any relevancy arguments that relate in any way to Plain-  
4 tiff's former claims (e.g., to establish damages and to prove  
5 Defendants' infringement of his technology) are now moot.

6 The foregoing notwithstanding, this case lives on, as  
7 Defendants currently have two counterclaims for declaratory relief  
8 pending against Plaintiff. (See Doc. Nos. 44, 45.) As explained  
9 below, Defendants seek to invalidate various claims in Plaintiff's  
10 patent ("2008 Patent") and render it unenforceable. As a result,  
11 only the relevancy arguments that bear on the counterclaims remain  
12 at issue.

13 **B. Plaintiff's Conclusory Statements Are Unpersuasive**

14 Although the main thrust of Plaintiff's motion is Microsoft's  
15 documents' relevancy to infringement and damages, Plaintiff inserts,  
16 seemingly as an afterthought, the following sentence at the end of  
17 each argument section: "[S]econdary considerations of non-obvious-  
18 ness regarding the [2008 Patent], including long-felt need, failure  
19 of others, and commercial success of the accused products."

20 Microsoft objects that these passages are conclusory and  
21 unhelpful: "This mere listing of unspecified factors is insuffi-  
22 cient to meet Plaintiff's burden of proving the relevance of his  
23 requests." (Doc. No. 8 at 9:1-2.) Microsoft continues:

24 For instance, what exactly are Plaintiff's equita-  
25 ble defenses resulting from Defendants' infringement"  
26 (he never identifies them) and how could they possibly  
27 relate to documents Microsoft might have in its posses-  
28 sion (he does not say)? And what do Microsoft's  
documents have to do with the validity of Plaintiff's  
patent? Moreover, the shotgun approach is not helpful  
to either Microsoft or the Court in determining whether  
the expense of conducting full custodial searches is  
warranted, and is precisely why Microsoft could not

1 reach agreement with Plaintiff. Plaintiff, for the  
 2 most part, makes no effort to align the requested  
 3 materials with the alleged "defenses" he has not even  
 identified or explain how exactly they would be rele-  
 vant.

4 (Id. at 11. 2-10.) For the most part, the Court agrees with  
 5 Microsoft's assessment. However, the Court notes that Microsoft's  
 6 representation that a "full custodial search" is necessary here is  
 7 inaccurate since it appears that Plaintiff has narrowed his requests  
 8 to documents that the so-called "Deal Team" produced or possessed.  
 9 Thus, Plaintiff's requests, as narrowed during meet and confer  
 10 efforts, no longer ask Microsoft to search the records of all of its  
 11 employees. In any event, Defendants are correct that Plaintiff's  
 12 cursory "shotgun" approach does not flesh out how the subpoenaed  
 13 documents are relevant to his "secondary considerations of non-  
 14 obviousness." Plaintiff's Reply does not flesh out this argument.  
 15 Without Plaintiff's adherence to the basic tenet of persuasive  
 16 writing (*i.e.*, "show me, don't tell me"), the Court is left to its  
 17 own devices to construct an argument that supports the documents'  
 18 relevance. The Court declines to do so. As a result, these  
 19 conclusory statements do not satisfy his initial burden to show the  
 20 relevancy of the documents he seeks.

21 **C. Frost's Reduction of the Invention to Practice**

22 Plaintiff's motion contains a final argument, that documents  
 23 requests 11, 13, and 14<sup>3/</sup> are relevant because they bear on Defen-  
 24 dants' counterclaim allegations that the 2008 Patent is invalid and

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25 <sup>3/</sup> Request 11 asks for "[a]ll Documents that were transferred by [law  
 26 firm, McDermott, Will & Emory, LLP] related to DATAlegro,  
 27 including, but not limited to, any documents transferred by MWE to  
 28 Microsoft employee Rachel Frodsham." Request 13 asks for "[a]ll  
 Documents Concerning the prosecution of the following U.S.P.T.O.  
 applications: 20050187977, 20060218190, and 20070299812." Request  
 14 asks for "[a]ll Documents Concerning the following application  
 numbers filed with the U.S.P.T.O.: 60/546,428; 11/059,510;  
 60/665,357; and 11/390,247."

1 unenforceable, and that Stuart Frost invented the disputed technol-  
2 ogy before Plaintiff did. (Doc. No. 1 at 14:3-4, 15:7-8 ("Frost  
3 claims to have invented what is claimed by the [2008 Patent] **before**  
4 Jardin did, thereby rendering the [2008 Patent] invalid . . . .")  
5 (emphasis in original).) Specifically, Jardin posits that the  
6 documents "should include notes or other evidence regarding when  
7 Frost conceived and reduced to practice Jardin's claimed inven-  
8 tions." (Id. at 14:5-6, 15:9-10.) The Court concludes that  
9 document requests 11, 13, and 14 reasonably bear on issues raised by  
10 Defendants' counterclaims.

11 In the summary judgment motion of invalidity, Defendants  
12 argue that filing timelines establish that the 2008 Patent antici-  
13 pates Frost's patent ("2010 Patent"), and the 2008 Patent is invalid  
14 as a result. (Doc. No. 179-1 at 7-9.) Defendants claim the 2010  
15 Patent is prior art to the 2008 Patent. However, even if this is  
16 true, application filing dates are not necessarily conclusive or  
17 dispositive, as the United States currently embraces a first-to-  
18 invent, not a first-to-file, patent system. Although Congress may  
19 change this soon, the law as it stands now provides that "[a] person  
20 shall be entitled to a patent unless":

21 [B]efore such person's invention thereof, the invention  
22 was made in this country by another inventor who had not  
23 abandoned, suppressed, or concealed it. In determining  
24 priority of invention under this subsection, there shall  
25 be considered not only the respective dates of conception  
and reduction to practice of the invention, but also the  
reasonable diligence of one who was first to conceive and  
last to reduce to practice, from a time prior to concep-  
tion by the other.

26 35 U.S.C. § 102(g)(2). An inventor may "swear back" to establish  
27 his inventorship up to one year prior to his application filing  
28 date. See 35 U.S.C. § 102(b). Importantly, "prior conception of

1 the invention by another does not defeat one's right. No possible  
2 barrier is created by § 102(g) unless another has either actually  
3 reduced the invention to practice or has constructively reduced it  
4 to practice by filing a patent application." In re Katz, 687 F.2d  
5 450, 454 (C.C.P.A. 1982).

6 In this case, timing matters. The 2008 Patent theoretically  
7 could be sworn back to March 23, 2003. However, since Frost has  
8 been granted the 2010 Patent, Microsoft's records may contain  
9 relevant information regarding Frosts reducing the invention at  
10 issue to practice.

11 Because Section 102(g) does not invalidate the 2008 Patent  
12 unless Frost "actually reduced the invention to practice," a factual  
13 dispute about the timing of Frost's and Plaintiff's reduction of the  
14 invention to practice could exist. Plaintiff's opposition to the  
15 summary judgment motion advances this argument. (See Doc. No. 193  
16 at 10-11.) Plaintiff's motion to compel does the same. (Doc. No.  
17 1 at 14:3-7, 15:6-10.) The Court finds that some documents in  
18 Microsoft's possession may be relevant to the extent that they  
19 potentially bear on this issue. As a result, the Court finds that  
20 Plaintiff has satisfied his burden of showing the relevance of these  
21 limited document requests.

22 Finally, Microsoft avers that it has "produced the file  
23 histories of Mr. Frost's patents," lists Bates stamp numbers of  
24 responsive documents it has apparently produced, and states that it  
25 "is unclear what additional information Plaintiff seeks." (Doc. No.  
26 8 at 14:12-17, 15:9-10.) This weighs against the claimed burden  
27 Microsoft will suffer, and the Court finds that the company will not  
28 suffer undue burden as a result of this limited Order. Of course,



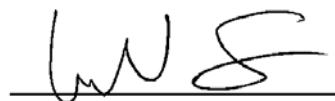
1 Microsoft need not produce duplicate documents. However, to the  
 2 extent that Microsoft's search reveals un-produced, responsive  
 3 documents (e.g., among the McDermott, Will & Emory files), Microsoft  
 4 shall produce those additional documents. If Microsoft's good-faith  
 5 search genuinely fails to uncover additional responsive documents,  
 6 then the company obviously has nothing left to produce, shall inform  
 7 Plaintiff, and file with the Court a declaration or other paper that  
 8 certifies as much.

#### 9 IV. CONCLUSION

10 Based on the foregoing, the Court DENIES IN PART Plaintiff's  
 11 motion as to document requests 1-10 and 12 and GRANTS IN PART  
 12 Plaintiff's motion as to requests 11, 13, and 14. However,  
 13 Microsoft shall not be compelled to produce the documents until  
 14 Judge Gonzalez's ruling on Defendants' summary judgment motion of  
 15 invalidity. In the meantime, Microsoft shall diligently search for  
 16 responsive documents and prepare them for production. If Judge  
 17 Gonzalez denies the motion, Microsoft shall produce the documents  
 18 within four (4) court days of Judge Gonzalez's order.<sup>4/</sup>

19 IT IS SO ORDERED.

20 DATED: May 9, 2011

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23 Hon. William V. Gallo  
 24 U.S. Magistrate Judge

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<sup>4/</sup> Of course, if Judge Gonzalez grants Plaintiff's pending motion to  
 dismiss, the issue is moot and Microsoft need not produce anything.